

REMARKS

Claims 1-7, 9-14, 16, and 18-24, as amended, and new claims 25-26 are pending in this application. In this Response, Applicants have amended certain claims in this response because Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1, 13, and 16 have been rewritten to clarify the invention. In addition, various dependent claims have been amended to maintain consistency with the language now recited in the independent claims. As no new matter has been added by the amendments herein, Applicants respectfully request entry of these amendments at this time.

THE REJECTION UNDER 35 U.S.C. § 112

Claims 1-7, 9-14, 16, and 18-24 were rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth on page 2 of the Office Action. Applicants respectfully disagree with the Examiner's rejection of these claims.

The first paragraph of 35 U.S.C. § 112 requires that a patent specification enable one skilled in the art to make and use the claimed invention. "The enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation." *AK Steel Corp. v. Sollac and Ugine*, 344 F.3d 1234, 1244 (Fed. Cir. 2003).

The specification clearly teaches that upper and lower limits of the ranges disclosed herein are interchangeable. Page 4, lines 30-31. As such, a skilled artisan would be able to practice any of the ranges taught on Pages 4-5 and interchange any of the upper and lower limits of those ranges. However, Applicants apologize for the inadvertent recitation of the range 100 parts to 200 parts in the independent claims as, after a more careful review of the specification, it appears that the 100 parts applies only to the base rubber and not the amount of pre-vulcanized or pre-crosslinked present in the composition. In an effort to remedy this mistake, the claims have been amended to recite a range of 125 parts to 200 parts (claims 1, 25, and 26) and 75 parts to 200 parts (claims 13 and 16).¹

¹ With regard to the previous combination of references, *i.e.*, Hiraoka and Maruko, Applicants

In light of the amendments to the claims, Applicants respectfully submit that these rejections are overcome. As such, Applicants respectfully request that the § 112 rejection be withdrawn.

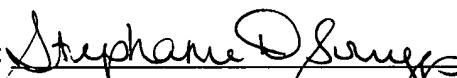
CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Fee Sheet Transmittal is submitted herewith to pay for the additional dependent claims added with this Response, as well as additional claim added in the September 15, 2005 response. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Bingham McCutchen LLP Deposit Account No. 195127, Order No. 20002.0269.

Respectfully submitted,
BINGHAM McCUTCHEN LLP

Dated: August 31, 2006

By: 

Stephanie D. Scruggs, Registration No. 54,432
BINGHAM McCUTCHEN LLP
3000 K Street, NW, Suite 300
Washington, D.C. 20007
(202) 424-7755 Telephone
(202) 295-8478 Facsimile

respectfully submit that the combination does not teach or suggest the presently recited ranges of pre-vulcanized or pre-crosslinked material. In fact, Hiraoka teaches away from amounts of vulcanized rubber powder greater than 35 parts by weight (Col. 4, lines 15-21) and Maruko merely suggests including up to 75 percent pre-crosslinked rubber powder (Col. 3, lines 24-28). With regard to claims 13 and 16, Maruko does not teach the recited range of 75 parts to 200 parts. And, as previously presented to the Examiner, Maruko teaches a mixture of a *thermoplastic* resin and a rubber powder, whereas Hiraoka is directed to a mixture of base rubber, *i.e.*, a *thermoset* material, and low levels of vulcanized rubber powder. As such, a skilled artisan would not have been motivated to combine the two references, especially with knowing the many processing and performance differences between the two types of materials, without the instant application to use as a template, which is, of course, a classic case of impermissible hindsight.